

## RESPONSE TO OFFICE ACTION

ATTY. DOCKET : RM.CH5  
APPLICANT : Symington, *et al.*  
US SERIAL NO. : 10/539,923  
US ENTRY DATE : February 21, 2006  
PCT SERIAL NO. : PCT/US03/01943  
INT'L FILING DATE : December 16, 2003

Examiner : Benjamin J. Packard

Art Unit : 1612  
Conf. No. : 90068399

## REMARKS

Amendments and arguments are presented herein to improve the form of the subject application and in response to the Examiner's comments in the above-identified Office Communication.

### ***Non-Responsiveness Under MPEP § 821.03***

The reply filed on 06/08/09 is again deemed by the Examiner not to be fully responsive to the prior Office Action because:

Applicants, according to the Examiner, again have amended the claims to require the active step of application of the pharmacologically-active substance to the tooth, then applying a coating over the pharmacologically-active substance.

The Examiner states that the amended language is not read as an intended use, given the active step is required by the claims. Additionally, the formulation is not a product-by-process limitation, given the coating may be applied to the pharmacologically active substance in a location beside on the tooth. Thus, the Examiner states that Applicants again are merging product and method claim limitations into one claim, creating a non-statutory hybrid claim. The Examiner continues by stating that, while this would normally be deemed objectionable during prosecution, Applicants elected a single statutory class invention in the election in the response filed 04/28/08. Where the statutory class is outside the elected invention, the Examiner has not entered the claim amendments and deems Applicants' prior communication to be non-responsive.

The Examiner continues the comment by stating that since the above-mentioned amendment appears to be a *bona fide* attempt to reply, Applicants are given a Time period of one (1) month or thirty (30) days, whichever is longer, from the mailing date of the Office Communication within which to supply the omission or correction in order to avoid abandonment.

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**APPLICANTS' RESPONSE**

Applicants respectfully incorporate herein the arguments proffered in the reply filed on 06/08/09.

The foregoing notwithstanding, Applicants have amended the claims, without prejudice, to the claims to delete the claimed "active step" of applying the pharmacologically-active substance to the tooth, and the further "active step" of applying a coating over the pharmacologically-active substance. Since the prior amendment was not entered by the Examiner, the present amendments to the claims are based on original claims 1-8.

More particularly, amended claims 1-8 have been amended to specify exclusively a formulation, which is entirely consistent with the original election, and which clearly constitutes patentable subject matter under 35 U.S.C. § 101. It is therefore respectfully asserted that the Examiner's objections to the entry of the previous amendment on the grounds of the amended claims being drawn to a non-elected invention, or as not specifying statutory subject matter under 35 U.S.C. § 101, have been overcome.

For reasons specified in the prior response, Applicants assert that there is present in the specification support for a formulation comprised of a pharmacologically-active substance applied directly onto a surface of the tooth of the patient and a further coating

***Claims Rejections***

With respect to the prior rejection of the claims under 35 U.S.C. § 112, 35 U.S.C. § 102, and 35 U.S.C. § 103, Applicants incorporate herein the arguments proffered in the amendment filed on 12/29/08.

***Conclusion***

In view of the foregoing, it is respectfully requested that the Examiner reconsider the present application, allow the claims, and pass the application for issue. If the Examiner believes that the prosecution of this case can be expedited by a telephone interview, the

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Examiner is requested to call attorney for Applicant at the telephone number indicated hereinbelow.

Respectfully submitted,



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enc      Annexure 1 - Claims Rewritten to Show Amendments  
File:     ROA-Comm2.CH5